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HW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,930	09/15/2003	Curtis W. Hallowell	47171-00413USPT	2736
30223	7590	05/27/2005	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			RAO, SHEELA S	
			ART UNIT	PAPER NUMBER
			2125	

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	HALLOWELL ET AL.	
10/662,930		
Examiner Sheela Rao	Art Unit 2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 15 September 2003.  
2a) This action is FINAL.                    2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-49 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 1-49 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on 15 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/10/03&2/7/05.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1-49 are presented for examination and are pending.
2. Applicant is requested to update disclosure with Patent numbers for the listed related applications.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 recites the limitation "the step of scanning" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 5 is dependent upon the limitations of independent claim 1. No where in claim 1 is a step of scanning set forth; therefore, further defining the device used for scanning is not clear and lacks antecedence.

5. Claims 19-21, 22-24, 31, 41, and 45-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The mere statement of desired result with no support within the body of the claim language does not provide for sufficient functionality for the claimed subject matter. No explanation or description for the usage of the claimed system to achieve the desired volume of output or speed is clearly stated or provided to allow for proper linkage between the claimed features.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Art Unit: 2125**

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7. Claims 1-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Horino et al. (US Patent No. 5,022531).

The patented invention by Horino et al. (hereinafter "Horino") teaches the procedure used in processing bundles of items or documents, namely currency. In the method used, bundles or stacks of currency are placed in an input portion or receptacle. In addition, take out and receiving means for transporting the bundles is included. A detecting means is present to detect the quantity of packs; along with a rejecting means which rejects the bundles that are not consistent with the quantity or assigned data. Then a stacking portion stacks the bundles to be further transported. Finally, a storage box is present to store the stacked portion of the bundles upon completion of processing. With regard to the limitations of instant claims 1, 13, 28, and 37; along with instant claims 10, 12, and 48, wherein the method and system for receiving a stack of documents, assigning searching identification, transportation of the stacks, detecting and evaluating the identifier, and then directing the stack for storage upon process completion is claimed. See column 2, lines 57, et seq., for details of the cited portion as described above.

With regard to the use of currency or other types of financial instruments, such as tickets, coupons, or cards, as per claims 2, 16-18 and 43, the prior art indicates that the patented invention may use bank notes or other financial instruments, as stated at line 12 in column 3. Stopping the process once the documents or currency is sent to an output receptacle as claimed by instant claim 3, is described with reference to an exemplary embodiment of the instant invention at column 9, line 35-41.

Claims 4, 14, 26-27, 35, 44, and 49 are all directed to the use of a ticket number as a means of identification. The processing system of the patented art comprises a stamping section for stamping the bundles. Stamping of data on the bundles for identifying the type of bundle being presented is disclosed, see column 3, line 40. The limitations of instant claims 5 and 25, limit the processing system to include a scanning or detecting means. Horino teaches the use of a scanning camera placed underneath the glass plate of the scanning surface. This image is then provided to the denomination checking unit that verifies/compares the denomination of the bundles with the input and image information. See column 3: II. 60, et seq. The directing of documents to subsequent or plural receptacles, as in claims 6-7, 19-21,

**Art Unit: 2125**

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and 45-47, is conducted by the transport and receiving means of the prior art as stated above. The setting of predetermined limits for accumulating or processing each bundle or stack of documents in a receptacle, as per claims 8, 31, and 40, is handled by the counting section which seals the bundles upon reaching its predetermined limit, see column 3: ll. 30-39. The reference of prior art teaches storage of data within its memory means as claimed by instant claims 9, 28, 33, and 36. The storage of a stack of documents being stored in a bag as per instant claim 34 is taught by Horino wherein the stack or bundle is stored in a box, which is analogous to a bag. The use of either an audible or visual indicator as per instant claims 11 and 15 is taught by the detecting device receiving and responding to a detection signal, see column 3: ll. 21-29. The transportation of the bundles based on the capacity of the system of the prior art, as per instant claims 22-24, is handled by the transport and receiving means as stated above (also see column 8, line 14-16). With regard to the identifier including a date and time stamp, as per instant claims 29, 30, 38, and 39, the stamping section along with an operational panel allows for the inclusion of time and amount data as taught by Horino in column 3: ll. 40-60. With regard to the printing of information as claimed by instant claims 32, 37, and 42, the printing of a slip or receipt by the printer that includes data regarding the documents or bundles is detailed by Horino in reference to the processing carried through in an exemplary embodiment of the patented invention at column 9: ll. 42-50. The presence of a printer as called for by instant claim 41 is inherent when the printing process is used for printing data or documentation.

Although the limitations of instant claims 19-21, 22-24, 31, 41, and 45-47 have been addressed above, it is noted that the cited features may not be directly analogous to the claimed limitations. Applicant is reminded; it has been held that the functional "wherein" statement does not define any structure and accordingly cannot serve to distinguish the limitations. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

For the reasons stated above, the limitations of the claimed invention is taught by the prior arts of record; thereby, rendering the instant claims unpatentable.

**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tamada USPN 4,641,753

Teaches of a mail sorting system, wherein the mail pieces are given barcode identification

Hickman PGPub. US2005/0025340 A1

Teaches of a process for automatically sorting mail with identification means

Allen et al. USPN 5,422,821

Teaches a process for identifying, intercepting, and forwarding mail

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela Rao whose telephone number is (571) 272-3751. The examiner can normally be reached Monday - Friday from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749. The fax number for the organization where this application or any proceeding papers is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. It should be noted that status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should any questions arise regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sheela S. Rao  
Patent Examiner  
GAU 2125